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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/636,660	08/11/2000	Tom Evslin	176/1	9188

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EXAMINER

NGUYEN, BRIAN D

ART UNIT	PAPER NUMBER
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2661

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/636,660

Applicant(s)

EVSLIN ET AL

Examiner

Brian D Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 4/2/04.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Objections*

1. Claims 9-10 are objected to because of the following informalities:

Claim 9, line 3, it is suggested to change "those address" to ---those addresses---.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al (6,587,867) in view of Galasso et al (6,374,302).

Regarding claims 1-3, Miller discloses an apparatus comprising a stored table of information (subscriber profile databases) indicative of plurality of parties to be contacted and within a local community of interest, the stored table including a network address for each party within the local community of interest, and an indicator of which of at least two networks (cellular network, PSTN, Internet) the address is a part; at least two network interface units, each for interfacing to a separate one of the at least two networks for receiving requests to contact parties; and a processor for completing the contact at the address and over the network stored in the table (see abstract; col. 1, lines 13-20; col. 5, lines 32-35). Miller does not specifically disclose contact a domain name server over the Internet if the party to be contacted is not in the local community of interest. However, Galasso discloses contacting the server if the party to be

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contacted is not in the local community of interest (see col. 2, lines 16-34; col. 2, lines 44-53; col. 4, line 41-col. 5, line 7). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to contact the server as taught by Galasso in the system of Miller so that call can be forwarded to its destination.

Regarding claims 4-5, Galasso further discloses receiving information from the DNS, to parse the information to ascertain a network address of a second server having a local community of interest of which the party to be contacted is a part, and for establishing communications over the Internet between the apparatus and the second server; monitoring signals received from the second server during call setup, and for determining when to begin transmission of audio communications (see 620, 630 of figure 4; col. 1, line 36-col. 2, line 5; col. 5, lines 58-64; col. 7, line 44-col. 8, line 7). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to contact the server and use the received information to establish a connection with the called party as taught by Galasso in the system of Miller in order to establish a communication between a source and a destination.

Regarding claim 6, claim 6 is a method claim that has substantially all the limitation of the respective apparatus claims 1-5. Therefore, it is subject to the same rejection.

Regarding claim 7, Galasso discloses the identification of the called party includes an email address associated with the called party (see table 1 in col. 5). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the email address as the identification as taught by Galasso in the system of Miller so that different addresses can be used to identify a called party.

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Regarding claims 8-10, Miller discloses using the graphical user interface to update the table (subscriber profile) (see col. 4, lines 26-32).

Regarding claims 11-15, claims 11-15 are method claims that have substantially all the limitations of the respective apparatus claims 1-5. Therefore, they are subject to the same rejection.

Regarding claims 16-18, Miller discloses the called party can change the table (subscriber profile) and prioritizing sets of information (see abstract; figures 10-12; col. 12, line 1-col. 13, line 20).

### ***Response to Arguments***

4. Applicant's arguments filed 4/2/04 have been fully considered but they are not persuasive.

The applicant argues on page 7 that *the Miller reference is directed to a system in which it is assumed that all call requests can be completed. There is no capability in the Miller reference to deal with a call request that cannot be completed.* The examiner disagrees because although Miller system does not explicitly disclose how to deal with a call request that cannot be completed, Miller system, as any other system that connected to the Internet, is capable of requesting a called party address to a remote server in order to establish a connection with the called party because the local server database is limited to local addresses and when an address is not found in the local database, a request for the address must be requested. In addition, Galasso explicitly disclose this limitation as discussed in the Office action. On page 8, the Applicant argued that *in contrast to the Miller reference, the gatekeepers of the Galasso reference always*

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*contact another entity to complete a call.* The examiner disagrees because as discussed above, each local gatekeeper will has its own local database storing local addresses of the subscribers. Therefore, the gatekeeper contacts another entity only if the called party is not local to the gatekeeper. Regarding claim 6 on page 9, the applicant argues that *both the Miller and Galasso reference fail to disclose or suggest an apparatus that ascertain if it is capable of completing the telephone call or make such a determination prior to contacting another entity.* This argument is not persuasive because Galasso does disclose this limitation as discussed above and the determination is performed when the gatekeeper search for the called party address in the gatekeeper's database. On page 10, the applicant argues that *Miller and Galasso completely devoid the third server "includes a stored table specifying whether said communications channel is to be formed over a data network or a telephone network".* The examiner disagrees because Galasso explicitly disclose this limitation. The third server is a server local to the called party where the address of the called party is stored. Galasso explicitly disclose a stored table specifying whether the communication channel is to be formed over a data network or a telephone network, see call routing 148 of figure 10 where a call can be routed to different destination in the telephone or data networks. Regarding claim 11, the arguments are the same as claims 1 and 6. The response to these arguments is discussed above. In conclusion, the combination of the Miller and Galasso references teach each and every feature recited in independent claims 1, 6, and 11. Therefore, the combination of the Miller and Galasso references is sufficient to render the claims 1, 6, and 11 and their dependent claims obvious under 35 USC, 103.

*Conclusion*

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian D Nguyen whose telephone number is (703) 305-5133. The examiner can normally be reached on 7:30-6:00 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Olms can be reached on (703) 305-4703. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Brian Nguyen', with a stylized, cursive script.

Brian Nguyen  
4/30/04